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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/735,646 | 12/16/2003 | Uri Amin | 1351VAS-US | 3539 |
| 32964 | 7590 | 01/03/2007 | EXAMINER | |
| DEKEKEL PATENT LTD., DAVID KLEIN BEIT HAROFIM 18 MENUHA VENAHALA STREET, ROOM 27 REHOVOT, 76209 ISRAEL | | | PELLEGRINO, BRIAN E | |
| | | ART UNIT | | PAPER NUMBER |
| | | | | 3738 |
| SHORTENED STATUTORY PERIOD OF RESPONSE | | MAIL DATE | DELIVERY MODE | |
| 3 MONTHS | | 01/03/2007 | PAPER | |

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/735,646 | ARNIN ET AL. | |
| | Examiner | Art Unit | |
| | Brian E. Pellegrino | 3738 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 05 October 2006.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-11 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
 Paper No(s)/Mail Date _____
- 4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date. _____.
 5) Notice of Informal Patent Application (PTO-152)
 6) Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 6 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. How can the shock absorbing material be a fluid if it has a shape of a Belleville washer?

Claim Rejections - 35 USC § 102

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-4,9 are rejected under 35 U.S.C. 102(e) as being anticipated by Ralph et al. (2003/69642). Fig. 6 shows a spinal prosthesis having an outer case formed of upper and lower plate members (100,200) and each include at least one anchoring element 102,202 respectively; paragraph 32. It can also be seen there is what can be construed as a cartridge 250. Ralph et al. also disclose to place a coating for bone-ingrowth about the outer surface, paragraphs 17,33,41. Ralph also discloses (Fig. 7) that within the cartridge is a shock absorbing Belleville washer 130.

Claim 10 is rejected under 35 U.S.C. 102(b) as being anticipated by Bryan et al. (2002/35400). Fig. 6 shows a spinal prosthesis having an outer case (22,42) on

cartridge formed of upper and lower plates **20,40**. Bryan et al. disclose (paragraph 77) a shock absorbing core (**60**) within the cartridge and surrounded by an elastic ring **70**. It can be seen that the ring is fixed to the housings by a mortise and tenon joint fixture.

Claim 11 is rejected under 35 U.S.C. 102(b) as being anticipated by Kyocera (JP 95121265). Fig. 2 shows a spinal prosthesis having an outer case of upper and lower plates C_1, C_2 and a cartridge having upper and lower housing halves P_1, P_2 that are slidingly attached to upper and lower plates respectively. Additionally it can be seen there is a shock absorbing core (**b**) within the cartridge that prevents collapse of the vertebrae.

Claims 1,3-6,8,9 (as best understood with respect to claim 6) are rejected under 35 U.S.C. 102(b) as being anticipated by Stubstad et al. (3867728). Fig. 2 shows a spinal prosthesis having an outer case formed of upper and lower plates **11,12** with bone growth coatings **21, 21'** (col. 8, line 42) and since these coatings permit ingrowth it can be construed that the coating layers are anchoring elements also, col. 8, lines 55-59. Stubstad et al. disclose the core is an elastomer, col. 9, lines 39-41. Fig. 6 illustrates the prosthesis has an inner member or "cartridge" having a shock absorbing core formed of a fluid, col. 9, lines 64-67. Please note the Examiner is not giving any special definition to the term "cartridge".

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5,7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ralph et al. (2003/69642) in view of Bryan et al. (2002/35400). Ralph et al. is explained supra. However, Ralph does not explicitly disclose the material for the shock absorbing component to be an elastomer or have different properties. Bryan et al. teach the shock absorbing core is an elastomer and can have different materials and properties, paragraph 88. It would have been obvious to one of ordinary skill in the art to utilize an elastomer or different mixed components for the shock absorber as taught by Bryan et al. in the prosthesis of Ralph et al. such that it provides a cushioning effect for the vertebrae.

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ralph et al. (2003/69642) in view of Mazda (WO 94/04100). Ralph et al. is explained supra. However, Ralph does not explicitly disclose an elastomeric ring about the shock absorbing member. Mazda teaches (Fig. 3) to place an elastomeric ring 10 about the central core member of the prosthesis, see abstract. It would have been obvious to one of ordinary skill in the art to utilize a shock absorbing ring as taught by Mazda with the prosthesis of Ralph et al. such that it provides more distribution of the compressive forces from the vertebrae.

Response to Arguments

Applicant's arguments with respect to claim 1 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian E. Pellegrino whose telephone number is 571-272-4756. The examiner can normally be reached on Monday-Thursday from 6:30am to 4pm. The examiner can also be reached on alternate Fridays.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott, can be reached on 571-272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

TC 3700, AU 3738



BRIAN E. PELLEGRINO
PRIMARY EXAMINER